



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Massague et al.

Serial No: 09/865,018

Filed: May 24, 2001

For: Isolated p27 Protein and Methods for  
Its Production and Use

Attorney Docket No. GPCI-P08-079

Art Unit: 1632

Examiner: Shin-Lin Chen

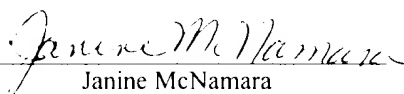
1632  
RECEIVED  
JUL 15 2003  
TECH CENTER 1600/2900

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450 on the date indicated below:

July 7, 2003

Date of Signature  
and of Mail Deposit

  
Janine McNamara

Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

**REPLY TO OFFICE COMMUNICATION**

Sir:

The Office Communication mailed June 13, 2003, in connection with the above application, acknowledges Applicants' election of Group VI (claims 32-35) in Paper No. 10. The Examiner also acknowledges the addition of claims 36-47.

In reply to the species election requirement in the Office Communication, Applicants hereby elect with traverse human p27 amino acid sequence as set forth in SEQ ID No. 2, as a single SEQ ID No. Applicants traverse the species election since the species subjected to election are encompassed by Markush groups. Pursuant to MPEP 803.02, "If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions." In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to

9194023\_1

non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02). In this case, it is Applicants' position that the members of the Markush group are "sufficiently few in number" and may be searched and examined without a serious burden on the Examiner.

Furthermore, Applicants note that MPEP § 803.04 states that "to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application." The MPEP goes on to state that "it has been determined that normally ten sequences constitute a reasonable number for examination purposes." Once again, Applicants submit that the present claims include less than 10 sequences and as such constitute a reasonable number of sequences for search and examination.


Accordingly, Applicants respectfully request reconsideration and withdrawal of the single sequence election requirement and request a search and examination of all three p27 amino acid sequences claimed herein.

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Respectfully Submitted,

Date: July 7, 2003

**Customer No: 28120**  
Patent Group LLP  
Ropes & Gray  
One International Place  
Boston, MA 02110  
Phone: 617-951-7000  
Fax: 617-951-7050

  
\_\_\_\_\_  
David P. Halstead  
Reg. No. 44,735